

## **REMARKS**

### **Claim Rejections – 35 U.S.C. § 102**

Claims 25-27, 29, 30, 36 and 37 were rejected as being anticipated by the disclosure of the U.S. Patent of Hart No. 5,584,845. Of the rejected claims, claim 25 is the only independent claim. It is respectfully submitted that the subject matter of the invention recited in claim 25 is not identically shown by the Hart reference, and therefore the reference does not anticipate claim 25 or its dependent claims 26, 27, 29, 30, 36 and 37.

For a prior-art reference to anticipate, every element of the claimed invention must be identically shown in a single reference.

*In Re Bond*, 910 F.2d 831, 15 USPQ 2d 1566, 1567 (Fed. Cir. 1990).

[A]ny degree of physical difference, however slight, invalidates claims of anticipation.

*Ultradent Products, Inc. v. Life-Like Cosmetics, Inc.*, 924 F. Supp. 1101, 39 USPQ 2d 1969, 1980 (D. Utah 1996), *aff'd in part, rev'd in part on other grounds*, 127 F.3d 1065, 44 USPQ 2d 1336 (Fed. Cir. 1997).

Of the subject matter of the invention recited in independent claim 25, the claim originally recited "at least one of the operative microsurgical surfaces having a series of serrations and each serration having a width dimension smaller than 0.007 of an inch." Furthermore, claim 25 has been amended herein to make clear that the width dimension referred to in the claim is the width dimension between adjacent peaks of each serration. This definition of the width dimension is supported in the application on page 17, lines 15-29.

In the rejection of claim 25, it is contended that the Hart reference discloses an instrument having serrations with each serration having a width dimension ranging from 0.0015 of an inch to 0.0039 of an inch. Column 5, lines 28 and 29 of the Hart reference is referenced for this disclosure. However, reading lines 23-29 of column 5, it is seen that this portion of the reference is referring to the shearing edge 30, an end view of which is shown in Figure 6. The shearing edge 30 extends along the blade face portion 28 of the blade 8. It is the width of the

edge 30 between the inner surface region 26 and the blade face portion 28 shown in Figure 6 that is described as being less than or equal to about 0.002 inches. There is no disclosure of a serration in this portion of the Hart reference, and there is no disclosure of a serration having adjacent peaks and a width dimension between the adjacent peaks that is smaller than 0.007 of an inch as recited in claim 25. The Hart reference does not identically show every element of claim 25, there are physical differences between the subject matter of claim 25 and the disclosure of the Hart reference, and therefore the Hart reference does not anticipate claim 25 under the above-cited case law. Claim 25 and its dependent claims 26, 27, 29, 30, 36 and 37 are therefore allowable over the prior art.

#### **Claim Rejections – 35 U.S.C. § 103**

Claim 28 was rejected as being anticipated by the Hart reference, or in the alternative, as being obvious in view of the Hart reference. However, as explained above, the Hart reference does not disclose or suggest serrations on a operative microsurgical surface of an instrument where each serration has a width dimension between adjacent peaks that are smaller than 0.007 of an inch. Because the reference has no suggestion of this subject matter of the invention, claim 28 which depends from claim 25, is allowable over the prior art.

It is further noted that the subject matter of claim 28 recites the serrations being a wire electric discharge machined surface. This is a physical feature of the serrations. The language of claim 28 is not describing the serrations being formed by wire electric discharge machining, as contended in the rejection of the claims. Because the Hart reference does not disclose or suggest wire electric discharge machined surfaces on a microsurgical instrument, the reference does not make obvious the subject matter of claim 28. For this additional reason, claim 28 is allowable over the prior art.

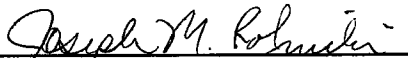
Claims 31-35 and 38-52 were rejected as being obvious in view of the combined disclosures of the Hart reference and the U.S. Patent of Toth et al. No. 6,616,683. Of the rejected claims, claims 43-46, 49, and 50 have been cancelled. Claim 47 has been amended into independent form, adding all of the subject matter of claims 43-46 to new independent claim 47. Claim 51 has also been amended into independent form, adding all of the subject matter of cancelled claims 43, 44, 49 and 50 to new independent claim 51. Claim 48 has been amended to depend from new claim 47, and claim 52 has been amended to depend from new claim 51.

Each of the independent claims 25, 47, and 51 has been amended herein to recite that the serrated surfaces of the invention have width dimensions between adjacent peaks of the serrations that are smaller than 0.007 of an inch. This subject matter of the invention is not disclosed or suggested by either the Hart or Toth et al. references. Without such a suggestions, the references cannot make obvious the subject matter of independent claims 25, 47, and 51.

It is respectfully submitted that the subject matter of the invention recited in independent claim 25, from which claims 26-42 depend, and the subject matter of new independent claims 47 and 51, from which claims 48 and 52 respectively depend, is not made obvious by the combined disclosures of the Hart and Toth references. In view of the amendments and remarks presented herein, the application is in condition for allowance and a favorable action is requested.

Respectfully submitted,

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